

## REMARKS

### Summary of the Office Action

Claims 55, 57, 58, 60, 61 and 63 are pending in this application.

Claims 55, 57, 58, 60, 61 and 63 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Legall et al. U.S. Patent No. 6,005,565 (hereinafter "Legall") in view of Schneidewend et al. U.S. Patent No. 6,182,287 (hereinafter "Schneidewend").

### Summary of Applicants' Reply

Applicants have amended claims 55, 58 and 61 to more particularly define the claimed invention. Applicants' claim amendments do not add any new matter and are fully supported by the originally filed specification. See, for example, paragraph [0132] of the application publication (Publication No. US 2005/0235319, hereafter "Application Publication"). Applicants respectfully traverse the § 103(a) rejection.

### The § 103(a) Rejection

Claims 55, 57, 58, 60, 61 and 63 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Legall in view of Schneidewend. This rejection is respectfully traversed.

Applicants' claimed invention, as recited in independent claims 55, 58 and 61, are directed to a history list feature that includes resources that were

accessed by a user. In particular, the history list includes a program guide display having data from a program guide database, a web site from the Internet, and a resource other than a program guide display or a web site. Accessing a resource causes the resource to be included in the history list. The user may select in any order any resource from the history list to access the history list resource.

The Examiner concedes that "Legall does not explicitly disclose providing a history list to a user and more specifically the claimed 'allowing a user to select in any order any resource from the history list; and in response to the user selecting a resource, providing the resource,'" as required by applicants' independent claims (Office Action, page 4). The Examiner attempts to fill this gap with Schneidewend. In particular, the Examiner points to a favorite service menu feature in Schneidewend.

Schneidewend discloses a favorite service menu containing entries from local and remote service sources (Schneidewend, FIG. 3; col. 4 ll. 53-54). The favorite services may be manually added to the favorites list by the user (Schneidewend, col. 4 ll. 62-63). This is in direct contrast with applicants' claimed invention, in which simply accessing a resource causes it to be added to the history list. Applicants' claimed invention requires no user instructions to add a resource to the history list.

Schneidewend also indicates that the favorite service menu may include automatically generated lists

for a specific user derived using (a) predetermined user preferences or (b) records of the most frequently used services (Schneidewend, col. 5 ll. 63-66). Generating a list from predetermined user preferences however, is very different than generating a history list of accessed resources in which accessing a resource causes it to be included in the history list. A list based on user preferences only includes resources preferred by the user. As a result, if an accessed resource is not deemed to be a user-preferred resource, it would not be included in the favorites list. In contrast, applicants' claimed history list includes previously accessed resources simply because they were accessed, not because of any quality or attribute of the resource; there is no analysis required to determine whether to include the accessed resource. Similarly, generating a list from records of the most frequently used services is also very different than generating a history list of accessed resources in which accessing a resource causes it to be included in the history list. A list based on records of the most frequently used services only includes resources most frequently used by the user. As a result, if an accessed resource is not deemed to be a most frequently used resource, it would not be included in the favorites list. In contrast, applicants' claimed history list includes previously accessed resources simply because they were accessed, not because of how often they were accessed; there is no analysis required to determine whether to include the accessed resource.

For at least the foregoing reasons, Schneidewend fails to make up for the deficiency of Legall at least because it fails to disclose providing a history list to a user, as recited by applicants' independent claims, let alone "allowing a user to select in any order any resource from the history list; and in response to the user selecting a resource, providing the resource."

In addition, the Office Action fails to articulate a legally sufficient rationale for rejecting the claims based on obviousness under 35 U.S.C. § 103(a). The Office Action does not specify which of the rationales set forth in the Examination Guidelines for Determining Obviousness Under 35 U.S.C. § 103 in view of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.* is relied upon to support the rejection (72 FR 57526). Instead, the Office Action simply alleges that "it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the method for providing a history feature in an integrated interactive television program guide, Internet and other information resources system of Legall with the additional features of providing a history list of the previous resources accessed by the user for the advantage of allowing a user to quickly access in any order previously viewed resources through a organized history list." Office Action p. 5. But this is nothing more than a statement as to what may be an advantage *if* one were to combine the alleged teachings of the references. This does not provide the required articulated reasoning

as to why a person of ordinary skill would combine the teachings of these references or why the claimed invention would be obvious in view of the references.

Indeed, applicants respectfully submit that this rejection is an example of the impermissible use of the inventors' disclosure as a blueprint for piecing together the prior art to defeat patentability - the essence of hindsight. "It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." In re Fitch, 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1992). Thus, a prima facie case of obviousness has not been established.

In sum, Legall and Schneidewend, whether taken alone or in combination, fail to show each and every feature of applicants' independent claims. For at least the foregoing reasons, applicants respectfully submit that independent claims 55, 58 and 61 are patentable. Accordingly, each of dependent claims 57, 60 and 63 is also patentable at least because it depends, directly or indirectly, from a patentable independent base claim. Applicants respectfully request that the rejections of claims 55, 57, 58, 60, 61 and 63 be withdrawn.

Conclusion

For at least the reasons set forth above, applicants respectfully submit that this application is in condition for allowance. Prompt consideration and allowance of this application are respectfully requested.

Respectfully submitted,

/Jimmy Cheng/

Jimmy Cheng  
Registration No. 56,045  
Attorney for Applicants

Ropes & Gray LLP  
Customer No. 75563  
1211 Avenue of the Americas  
New York, New York 10036  
Tel.: (212) 596-9000